

**REMARKS**

**Objection to the Claims**

Claim 17 is objected to as having inconsistent terminology or vague as discussed on page 2 of the Office Action. Applicant asserts that the claim does not contain inconsistent terminology and is not vague. Applicant notes that in claim 17 the portion that begins at line 12 and the portion that begins at line 18 both reject the object being presented for validation, but both also have a condition that prevents the rejecting if met. Therefore, these statements are not inconsistent with the portion beginning at line 24 of claim 17. Applicant respectfully requests the withdrawal of the objection of record.

**Rejection under 35 U.S.C. §103(a)**

Claims 1-16 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moore ('729) in view of Copella ('988).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

The Office Action admits that Moore does not teach having object rejection. The Office Action attempts to cure this deficiency by introducing Copella, which the Office Action alleges to teach having such an element. The motivation for making the combination was presented as follows:

“It would have obvious ... to modify Moore according to the teaching of Copella because by providing optically sensed variable translucency characteristic which recorded on the document prior to use and compared to sensed characteristic previously pre-recorded on the document to verify the authenticity of the document from forgery.”

It is well-settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The given motivation does not state the desirability of including the object rejection into the Moore reference. The motivation discusses the forgery detection of Copella. Moore already has an anti-counterfeiting system and therefore would not benefit from combination with the teaching of Copella. Thus, the provided motivation is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Moore and Copella is desirable. Therefore, the rejection of claims 1-16 and 18-20 should be withdrawn.

The Office Action admits that Moore does not teach having object rejection. The Office Action attempts to cure this deficiency by introducing Copella, which the Office Action alleges to teach having such an element. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention. *div 19*

Claim 1 defines a method comprising, in part, of modifying the data in said first data set to create a second data arrangement for said first data set. Moore does not teach at least this limitation. The Office Action points to the text of Moore at column 15, lines 37-46, which discusses data matrix symbology, as purportedly disclosing the first data set having a first data arrangement. The Office Action then points to the text of Moore at column 30, lines 45-56, for teaching modifying the data in the first data set to create a second data arrangement of the first data set. This portion of Moore does not teach using this claim limitation. In other words, there is no discussion of modifying the data in the first data set to create a second data arrangement of the first data set. Thus, Moore does not teach at least this claimed limitation; Copella is not relied upon as teaching this limitation, and does not teach this limitation. Therefore, the Applicant respectfully asserts that for at least the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 18 defines a system comprising, in part, a first data set having data in a first data arrangement, the data within the first data set being modifiable to create a second data arrangement for said first data set. Moore does not teach at least this limitation. The Office Action points to the text of Moore at column 15, lines 37-46, which discusses data matrix symbology, as purportedly disclosing the first data set having a first data arrangement. The Office Action then points to the text of Moore at column 30, lines 45-56, for teaching the data set being modifiable to create a second data arrangement of the first data set. This portion of Moore does not teach using this claim limitation. In other words, there is no discussion of the data within the first data set being modifiable to create a second data arrangement for said first data set. Thus, Moore does not teach at least this claimed limitation; Copella is not relied upon as teaching this limitation, and does not teach this limitation. Therefore, the Applicant respectfully asserts that for at least the above reasons claim 18 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 20 defines a system comprising, in part, a data processing system for modifying data within a computer readable storage device having a first data arrangement to create a second data arrangement for said data. Moore does not teach at least this limitation. The Office Action points to the text of Moore at column 15, lines 37-46, which discusses data matrix symbology, as purportedly disclosing the data having a first data arrangement. The Office Action then points to the text of Moore at column 30, lines 45-56, for teaching modifying the data to create a second data arrangement of the data. This portion of Moore does not teach using this claim limitation. In other words, there is no discussion of modifying the data to create a second data arrangement for said data. Thus, Moore does not teach at least this claimed limitation; Copella is not relied upon as teaching this limitation, and does not teach this limitation. Therefore, the Applicant respectfully asserts that for at least the above reasons claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-15 and 19 depend from base claims 1 and 18, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-15 and 19 sets forth features and limitations not recited by the combination of Moore and Copella. Thus, the Applicant respectfully asserts that for at least the above reasons claims 2-15 and 19 are patentable over the 35 U.S.C. § 103(a) rejection of record, and the rejection should be withdrawn..

Application No.: 09/774,728

Docket No.: 10004878-1

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004878-1, from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256035363US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 12-30-2003

Signature: 

John Pallivathukal

Respectfully submitted,

By 

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

Dated: December 30, 2003

(214) 855-8186